The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte A. DAVID ERPELDING, DARRELL D. PALMER,
OSCAR J. RUIZ and SURYA PATTANAIK

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Appeal No. 1998-2566
Application 08/685,420

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ON BRIEF

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Before KRASS, JERRY SMITH and GROSS, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 2, 3, 5-8, 10, 11, 15-18, 24, 25, 27 and 34, which constitute all the claims remaining in the application.

The disclosed invention pertains to a suspension system for supporting a magnetic read/write slider.

Representative claim 2 is reproduced as follows:

2. A suspension system for supporting a magnetic read/write slider comprising:

a load beam for mechanically supporting a slider;

a slider support member for providing a region on which the slider can be mechanically attached;

a flexure having less stiffness than the load beam and connecting the load beam to the slider support member, the flexure comprising a first flexible finger region extending along a first outside edge of the flexure and a second flexible finger region extending along a second outside edge of the flexure, the first flexible finger region and the second flexible finger region each comprising a multilayered material comprised of a first layer, a second layer positioned over the first layer, and a third layer positioned over the second layer, the first layer comprising a metal, the second layer comprising a dielectric material and the third layer comprising an electrically conductive material with the first flexible finger region being connected to the slider support member by at least a part of the first layer and the second flexible finger region being connected to the slider support member by at least a part of the first layer;

at least one slot that extends completely through the first layer of the first flexible finger region; and

at least one electrical conductor formed in the third layer of the first flexible finger region and positioned over the slot.

The examiner relies on the following references:

Erpelding et al. (Erpelding)	4,996,623	Feb. 26, 1991
Picault et al. (Picault)	5,026,434	June 25, 1991

Claims 2, 3, 7, 8, 10 and 16 stand rejected under 35

U.S.C. § 102(b) as being anticipated by the disclosure of Erpelding. Claims 5, 6, 11, 15, 17, 18, 24, 25, 27 and 34 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Erpelding taken alone with respect to claims 5, 17 and 24, and the examiner adds Picault with respect to claims 6, 11, 15, 18, 25, 27 and 34.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon does not support any

of the rejections as formulated by the examiner. Accordingly, we reverse.

We consider first the rejection of claims 2, 3, 7, 8, 10 and 16 under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Erpelding. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how he reads the claimed invention on the disclosure of Erpelding [answer, pages 4-5]. With respect to independent claim 2, appellants argue that the flexure in Erpelding is the area located above slot 47. Thus, appellants argue that since there is a space 47 in the first layer between the link portion and the slider support member,

there is no connection of the first and second finger regions to the slider support member along the first layer as recited in

claim 2 [brief, pages 4-7]. The examiner maintains his position that the flexure in Erpelding is comprised of areas 24, 34 and 54, and the examiner asserts that the slider support member is the adhesive which provides a region where the slider is mechanically attached. The examiner finds that the first and second fingers of Erpelding are connected to this adhesive by way of element 32 on the first layer [answer, pages 9-11].

We agree with the position argued by appellants. Although we admire the imaginative way in which the examiner has attempted to read the claimed invention on the disclosure of Erpelding, we are nevertheless compelled to find that the examiner's interpretation of the claimed invention and the corresponding structure of Erpelding is not reasonable.

In our view, the first unreasonable interpretation made by the examiner is the finding that elements 24, 34 and 54 of Erpelding comprise the flexure. Appellants argue that these elements comprise the load beam. The load beam and flexure are well established terms of art in this field. As disclosed by Erpelding, "[t]he load beam provides the resilient spring action which biases the slider toward the

surface of the disk, while the

flexure provides flexibility for the slider as the slider rides on the cushion of air between the air bearing surface and the rotating disk" [column 1, lines 43-48]. From these "definitions" it would appear that elements 24, 34 and 54 provide the function of the load beam while the area above slot 47 provides the function of the flexure. The flexure must occur right at the slider and cannot be located a substantial distance away on a rigid member. Erpelding describes elements 24, 34 and 54 as link portions. Appellants' specification makes several references to the fact that the link portion of the assembly is the same as the load beam [pages 12 and 16, for example]. We find it inconsistent to read the flexure of the claimed invention on what is clearly the load beam of the reference.

The second unreasonable interpretation made by the examiner is the finding that the slider support member of Erpelding is a conventional adhesive in which the slider is mechanically attached [answer, page 9]. There is no discussion of this conventional adhesive in Erpelding or exactly where it would be located if it is present in Erpelding. Thus, it is impossible to make a determination

that this adhesive, if

present, is connected to the first and second finger regions of the flexure as recited in claim 2. We are also unpersuaded by the examiner's assertion that this connection includes a part of the first layer as claimed. As appellants point out, the drawings of Erpelding show no connection between the first layer and a slider support member. The examiner's contention that this connection exists is pure speculation.

Since we find that every feature of independent claim 2 is not contained within the disclosure of Erpelding, we do not sustain the rejection of claim 2 or of claims 3, 7, 8 and 10 which depend therefrom.

With respect to independent claim 16, appellants argue that the specific claimed connection of the load beam to the slider support member through the flexure is not disclosed by Erpelding [brief, page 7]. Since the examiner's finding of anticipation with respect to claim 16 is based on the same unreasonable interpretation of Erpelding discussed above, we do not sustain the examiner's rejection of claim 16.

We now consider the rejection of claims 5, 6, 11, 15, 17, 18, 24, 25, 27 and 34 under 35 U.S.C. § 103. In rejecting claims

under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443,

1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

Each of the examiner's rejections under 35 U.S.C. § 103 fundamentally relies on the improper finding of anticipation discussed above. Because of this improper finding of anticipation, the examiner has never addressed the obviousness of the differences between the claimed invention and the teachings of Erpelding. Therefore, the examiner's rejections under 35 U.S.C. § 103 do not establish a prima facie case of obviousness.

Accordingly, we do not sustain either of the examiner's rejections under 35 U.S.C. § 103.

In summary, we have not sustained any of the examiner's rejections of the appealed claims. Therefore, the decision of the examiner rejecting claims 2, 3, 5-8, 10, 11, 15-18, 24, 25, 27 and 34 is reversed.

REVERSED

ERROL A. KRASS Administrative Patent Judge	)	
JERRY SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ANITA PELLMAN GROSS Administrative Patent Judge	)	

Appeal No. 1998-2566
Application 08/685,420

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